

C. REMARKS

Applicants respectfully request reconsideration of the outstanding rejections and reexamination of the present application in light of the following amendments and remarks.

Status of the Claims

Claims 1-32 are pending in the application. Claims 1-4, 6-8, 17-19, 21-23 and 32 are amended.

Applicants note that the most recent Non-Final Office Action in the present application, dated February 12, 2009, states that the Office Action is in response to the communication filed on June 26, 2007, which was an Appeal Brief filed by Applicants and that the application was withdrawn from appeal and prosecution reopened responsive to an Order Remanding Appeal to Examiner dated January 30, 2009. [Office Action, p. 2] Applicants respectfully note that Applicants have now filed three Appeal Briefs in the present application and that the Examiner has withdrawn the application from appeal three times. The most recent withdrawal from appeal required the Examiner to issue a rejection under 35 USC §101. Applicants respectfully request that prior to issuance of any final rejection, if the Examiner continues to be confused by the specification, as noted in the Examiner's objection, that the Examiner contact Applicants' representative and provide an opportunity for resolution of any issues the Examiner finds objectionable.

Alleged Rejection under 35 USC §101, Claims 1-15 and 32

The Office Action rejects claims 1-15 and 32 under 35 USC §101 as allegedly directed to non-statutory subject matter. [Office Action, p. 2] In particular, the Office Action states "claims 1-15 of the instant application are set forth as method claims that may not fall within one of the four statutory categories of invention recited in 35 USC 101" based on a memorandum entitled "Clarification of Processes" under 35 USC 101" which is further used in conjunction with the Interim Guidelines and the Manual of

Patent Examining Procedures 2106.IV.B when determining whether a claimed invention falls within a statutory category of invention. [Office Action, p. 2] The Office Action concludes “claims 1-15 and 32 are rejected as being directed to a non-statutory subject matter since the claims are not (1) tied to another statutory class (such as a particular apparatus) or (2) do not transform the underlying subject matter (such as an article or materials) to a different level as required by the memorandum mentioned.” [Office Action, pp. 2-3]

Applicants note that in “Clarification of Processes” memo, there is a statement that “to qualify as a 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps.” *Clarification of Processes Memo*, page 2.

Applicants do not concede that the current interpretation of *In re Bilski* stated in the Clarification of Processes memo is correct, however, for purposes of advancing prosecution only, as shown in the listing of the claims, Applicants amend claims 1 and 32 to recite a statutory class to which the process is tied by identifying a controller within a phone unit (claim 1) and a controller of a cellular telephone unit (claim 32) as the apparatus that accomplishes the method recited in claims 1 and 32. Applicants note that paragraphs 0016-0019 of the present invention fully support the amended elements, and in particular, specifically teach the controller of a phone unit for performing the method recited in claims 1 and 32, and also in claims 2-14, which are dependent upon claim 1. Claims 1-15 and 32 are clearly directed to statutory subject matter, and as such, Applicants respectfully request withdrawal of the rejection of claims 1-15 and 32 under 35 USC 101.

Claim Objections, Claims 2-4 and 17-19

The Office Action objects to claims 2 and 17 because of the following alleged informalities: “claims 2 and 17 recite, “summing the modified call count”. Received is “a call” and modified is “the call”, as shown in claim 1. Since there is no more than one

call indicated, appellant needs to clearly/show how and into what a call (one call) can be modified.” [Office Action, p. 3] Applicants do not concede that the objection of claims 2 and 17 is correct. Solely making the amendment to more closely conform to the language in the specification, Applicants amend claims 2 and 17 as follows:

Claim 2 (Currently Amended): The method of claim 1 further comprising; summing the modified call count with at least one other call count from at least one other call; and determining an accumulated call count from the summing.

Claim 17 (Currently Amended): The computer usable medium of claim 16 further comprising; computer readable program code for summing the modified call count with at least one other call count from at least one other call; and computer readable program code for determining an accumulated call count from the summing.

Applicants submit that the amended elements in claims 2 and 17 are fully supported throughout the specification, and in particular in paragraph 0026 of the specification, therefore no new matter is added through the amendment to the claims. Applicants respectfully note that the call count is determined based on time increments, as per the claimed elements of claim 1. Claims 2 and 17 now teach summing the modified call count with at least one other call count from at least one other call and determining an accumulated call count from the summing, which are not informal.

The Office Action objects to claims 3 and 18 because of the following alleged informalities: “the claims recite ‘subtracting the modified call count from a time ration’. Although such a description exists in the disclosure, examiner finds it difficult to understand since the feature contradicts the convention of measuring units, which are conventions/norms in arithmetic. According to the recited feature, a call count (call per time) is being subtracted from time ration, which is a fraction of time.” [Office Action, p. 3] Applicants do not concede that the objection of claims 3 and 18 is correct. In particular, the Examiner’s conclusion as to subtracting the modified call count from a time ration of “although such a description exists in the disclosure, examiner finds it

difficult to understand since the feature contradicts the convention of measuring units, which are convention/norms in arithmetic" is not well founded.

The modified call count of claims 3 and 18 is determined based on time increments, as per the claimed elements of claims 1 and 16. In addition, Applicants note that paragraph 0027 of the specification specifically teaches subtracting the modified call count from a time ration. The specification and the claims speak for themselves and are not informal. It is only the Examiner, and not the specification or the claims, that has assigned incongruous units to the terms "modified call count" and "time ration", without providing any source for the Examiner's alleged "conventions/norms in arithmetic".

That said, solely making the amendment to more closely conform to the language in the specification, Applicants amend claims 3 and 18 as follows:

Claim 3 (Currently Amended): The method of claim 1 further comprising; subtracting the modified call count from a time ration; and determining a remaining call count from the subtracting [[time]].

Claim 18 (Currently Amended): The computer usable medium of claim 16 further comprising;
computer readable program code for subtracting the modified call count from a time ration; and
computer readable program code for determining a remaining call count from the subtracting [[time]].

Applicants submit that the amended elements in claims 3 and 18 are fully supported throughout the specification, and in particular in paragraph 0027 of the specification, therefore no new matter is added through the amendment to the claims.

The Office Action objects to claims 4 and 19 because of the following alleged informalities: "the claims recite 'rounding the call count'. The specification clearly provides rounding time; but it does not say/show how a call count is rounded. Besides, a call count deems to be a whole number that does not require rounding. Furthermore, claim 1 does not provide counting more than one call and examiner does not see how and into what one call could be rounded off." [Office Action, pp. 3-4] Applicants do not concede that the objection of claims 4 and 19 is correct. In particular, that the claim does not "say/show how a call count is rounded" does not make the claim informal, and

that “a call count deems to be a whole number that does not require rounding” does not render the claim information. That said, solely making the amendment to more closely conform to the language in the specification, Applicants amend claims 3 and 18 as follows:

Claim 4 (Currently Amended): The method of claim 1 wherein modifying the call count comprises rounding the call count up to a nearest whole minute based on a setting in the calling plan parameters to round to the next whole minute.

Claim 19 (Currently Amended): The computer usable medium of claim 16 wherein modifying the call count comprises rounding the call count up to a nearest whole minute based on a setting in the calling plan parameters to round to the next whole minute.

Applicants submit that the amended elements in claims 4 and 19 are fully supported throughout the specification, and in particular in paragraph 0020 of the specification, therefore no new matter is added through the amendments to the claims.

Applicants respectfully request withdrawal of the objections to claims 2-4 and 17-19.

Alleged Rejection under 35 USC 102, Claims 1, 2, 6, 16, 17, 21, and 31

The Office Action rejects claims 1, 2, 6, 16, 17, 21, and 31 under 35 USC §102(e) as being anticipated by Lahtinen (US Patent 6,275,708). [Office Action, p. 4] Applicants traverse the rejection of claims 1, 2, 6, 16, 17, 21, and 31. In order for this rejection under §102(e) to stand, each and every element of the claims must be disclosed in as great detail by the reference as claimed. “A claim is anticipated only if each and every element as set for the in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil. Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *See also* MPEP §2131.02 “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 1, 16, and 31

Claim 1, currently reads:

Claim 1 (Currently Amended): Method of tracking communications usage time by a controller within a phone unit during a call comprising:
counting time increments in response to [[a]] the call;
determining a call count based on time increments; and
modifying the call count based on calling plan parameters.

Applicants respectfully submit that at a minimum, Lahtinen does not teach or enable each and every element of the method by a controller within a phone unit during a call as claimed in claim 1. Lahtinen describes a method performed by a mobile serves switching centre, not by a phone unit. *Lahtinen*, col. 3, lines 16-20 and 48-52. No mention of a method of tracking communication usage time by a controller within a phone unit during a call is included in the disclosures of Lahtinen.

In addition, Applicants respectfully submit that at a minimum, Lahtinen does not teach or enable each and every element of modifying the call count based on calling plan parameters as claimed in claims 1, 16, and 31. The Office Action cites Lahtinen, abstract, col. 4, lines 3-26 and claims 1 and 7 as reading on the claimed element of modifying the call count based on calling plan parameters. [Office Action, p. 4] The Office Action states "as can be clearly seen, particularly in fig. 3, calls are counted based on time (hence both calls and time are counted) and calls are added, hence modified. As also can be clearly seen, particularly in the abstract, a page load of a communication system is limited based on the number of calls initiated in a given time interval. Examiner surmises that limiting a call is a calling plan, and number of calls and time intervals are the call limiting/calling plan/parameters." [Office Action, pp. 4-5]

First, Applicants respectfully submit that the Examiner has misinterpreted the disclosure of Lahtinen and that the reference does not teach or enable modifying a time increment based call count. When claims 1, 16, and 31 are each considered as a whole, the call count of claims 1, 16, and 31 is determined based on time increments counted in response to a call. At most, Lahtinen describes a call counter set to a maximum number of calls and decremented for each call initiated with a mobile services

switching centre over a time interval, a call timer set to count a time interval, and the mobile services switching centre for blocking any new calls if the call counter reaches zero within the time interval. *Lahtinen*, abstract, col. 3, lines 24-35, col. 4, lines 3-46, Figure 3, claims 1 and 7. Neither *Lahtinen* nor the Office Action cites any teaching of both determining a call count based on time increments and modifying the time increment based call count.

Second, Applicants respectfully submit that the Examiner has misinterpreted the disclosure of *Lahtinen* and that the reference does not teach or enable modifying the call count based on calling plan parameters. Applicants note that *Lahtinen* describes a system for preventing mobile system overload while storing or updating location information relating to mobile stations in a VLR. *Lahtinen*, col. 2, lines 11-14. At most, *Lahtinen* describes a mobile network infrastructure for limiting the number of calls over a time interval through each mobile switching centre, without regard to any calling plan. *Lahtinen*, abstract, col. 1, line 60-col. 2, line 9, col. 2, line 15-24, col. 3, lines 24-35, col. 4, lines 3-46, Figure 3, claims 1 and 7. Contrary to the Examiner's proposal, when *Lahtinen*'s teachings are considered, *Lahtinen*'s description of limiting the number of calls through a switching centre over a particular time interval does not teach a call plan, nor does the maximum call counter value or time interval value set for a mobile centre qualify as calling plan parameters.

No mention of calling plan parameters is included in the disclosures of *Lahtinen*.

Applicants respectfully request withdrawal of the rejection of claims 1, 16, and 31.

Claims 2, 6, 17, and 21

Claims 2, 6, 17, and 21 depend from independent claims 1 or 16 and are therefore allowable for at least the same reasons that claims 1 and 16 are allowable. Applicants respectfully request withdrawal of the rejection of claims 2, 6, 17, and 21.

In addition, with respect to claims 2 and 17, Applicants respectfully submit that *Lahtinen* does not teach or enable each and every element of claims 2 and 17 because

Lahtinen does not teach or enable summing the modified call count with at least one other call count from at least one other call. At most, Fig. 3 of Lahtinen describes decrementing a call counter for each call initiated with a mobile service centre. The call counter of Lahtinen does not teach the modified time increment based call count of claims 2 and 17 and decrementing the call counter of Lahtinen does not teach summing the modified call count with at least one other call count from at least one other call.

Therefore, because Lahtinen does not teach or enable at least one element of claims 2 and 17, Lahtinen does not anticipate claims 2 and 17 and the claims should be allowed.

In addition, with respect to claims 6 and 21, Applicants respectfully submit that Lahtinen does not teach or enable each and every element of claims 6 and 21 because Lahtinen does not teach or enable reducing the call count proportional to a pre-determined discount specified in the calling plan parameters for discounting an incoming call. Applicants have amended claims 6 and 21 to more closely conform to the language in paragraph 0022 of the specification and no new matter is added through the amendment. At most, Lahtinen describes decreasing a call counter for each new call initiated with a mobile service centre. Decreasing a call counter does not teach or enable reducing a time interval based call count proportional to a pre-determined discount specified in the call plan parameters for discounting an incoming call. Therefore, because Lahtinen does not teach or enable at least one element of claims 6 and 21, Lahtinen does not anticipate claims 6 and 21 and the claims should be allowed.

Alleged Obviousness under 35 USC 103(a), Claims 3-5, 7-15, 18-20, 22-30 and 32

The Office Action rejects claims 7-8, 22-23, and 32 under §103(a) as being unpatentable over Lahtinen in view of Toda (assigned to NEC Corp)(JP 07066909) [Office Action, p. 6], claims 3 and 18 under §103(a) as being unpatentable over Lahtinen as applied to claims 1 and 16, and further in view of Schwedes et al (DE 19646892 A1)[Office Action, p. 8], claims 4 and 19 under §103(a) as being unpatentable

over Lahtinen as applied to claims 1 and 16 and further in view of Abe et al (US Patent 5,966,509) [Office Action, p. 9], claims 5 and 20 under §103(a) as being unpatentable over Lahtinen as applied to claims 1 and 16 and further in view of Kraushaar et al. (US Patent 4,200,771)[Office Action, p. 10], and claims 9-13 and 24-28 under §103(a) as being unpatentable over Lahtinen as applied to claims 1 and 16 and further in view of Spitaletta et al. (US Patent 6,112,077)[Office Action, p. 10].

As to claims 3-5, 7-15, 18-20, and 22-30, Applicants respectfully submit that because these claims are dependent upon claims 1 and 16, which are allowable, claims 3-5, 7-15, 18-20 and 22-30 are not obvious and should be allowed. *In re Fine*, 837 F.2d 1071, 5 USPQ 1596 (Fed. Cir. 1988).

In addition, Applicants traverse the rejections of claims 7-8, 22-23, and 32 and 4 and 19 and respectfully submit that the claims are not obvious as discussed below.

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

The Examiner bears the initial burden of supporting any prima facie conclusion of obviousness. See *In re Rinehart*, 531, F.2d 1048, 189, USPQ 143 (CCPA 1976); *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007); MPEP 2142. The key to supporting a rejection under 35 USC 103 is the clear articulation of the reasons why the claimed invention would have been obvious; the analysis supporting a rejection under 35 USC 103 should be made explicit. See *KSR International Co.*, 82 USPQ2d at 1396; MPEP 2142 (Rev. 6, Sept. 2007).

Applicants respectfully submit that when a proper Graham inquiry is made a prima facie case of obviousness is not established and the claims should be allowed.

Claims 7-8, 22-23, and 32

The Office Action rejects claims 7-8, 22-23, and 32 under 35 USC 103(a) as being unpatentable over Lahtinen in view of Toda (JP 07066909A). [Office Action, p. 7]

As to claim 32, the claim currently reads:

Claim 32 (Currently Amended): A method of tracking communications usage time by a controller of a cellular telephone unit during a call comprising:
counting time increments by a timer in response to [[a]] the initiation of a call;
determining a call count of a total duration of the call based on time increments counted by the timer;
modifying the call count based on calling plan parameters for the cellular telephone unit; and
storing the modified call count in the memory of [[a]] the cellular telephone unit.

Applicants note that claim 32 is amended to more closely conform to the language in paragraph 0019 of the specification and to address the objection and no new matter is added through the amendment. Although Applicants amend the claim in the present application, Applicants do not concede that the Examiner has established a prima facie case of obviousness as to the claims as originally presented.

In performing a Graham inquiry as to claim 32, in considering the scope and contents of the prior art, the Examiner cites Lahtinen as reading on modifying the call count based on calling plan parameters for the same reasons as recited with regard to claim 1. [Office Action, p. 7] Applicants respectfully submit that the Examiner has erred in interpreting the scope and contents of Lahtinen as reading on modifying the call count based on calling plan parameters for the following reasons.

First, Applicants continue to submit that Lahtinen does not teach modifying a time increment based call count. When claim 32 is considered as a whole, the call count of claim 32 is determined based on time increments counted in response to a call. At

most, Lahtinen describes a call counter set to a maximum number of calls and decremented for each call initiated with a mobile services switching centre over a time interval, a call timer set to count a time interval, and the mobile services switching centre for blocking any new calls if the call counter reaches zero within the time interval. *Lahtinen*, abstract, col. 3, lines 24-35, col. 4, lines 3-46, Figure 3, claims 1 and 7. Neither Lahtinen nor the Office Action cites any teaching of both determining a call count based on time increments and modifying the time increment based call count.

Second, Applicants continue to submit that Lahtinen does not teach modifying the call count based on calling plan parameters. At most, Lahtinen describes a mobile system for limiting the number of calls over a time interval through each switching centre, without regard to any calling plan. *Lahtinen*, abstract, col. 1, line 60-col. 2, line 9, col. 2, line 15-24, col. 3, lines 24-35, col. 4, lines 3-46, Figure 3, claims 1 and 7. Contrary to the Examiner's proposal, when Lahtinen's teachings are considered, Lahtinen's description of limiting the number of calls through a switching centre over a particular time interval does not teach a call plan, nor does the maximum call counter value or time interval value set for a mobile centre qualify as calling plan parameters. No mention of calling plan parameters is included in the disclosures of Lahtinen.

Third, Applicants respectfully submit that Lahtinen does not teach a method of tracking communications usage time by a controller of a cellular telephone unit during a call. Lahtinen describes a base mobile services switching center of a mobile telephone network performing the steps described in Figure 3 of Lahtinen. *Lahtinen*, col. 3, lines 9-46, col. 4, lines 3-9. Lahtinen does not describe performing any counting of any calls or the duration of any calls within any cellular telephone unit.

In addition, as to claim 32, in considering the scope and contents of the prior art, the Examiner correctly states that "Lahtinen does not explicitly teach about storing the modified call count in the memory of a cellular telephone unit." [Office Action, p. 7] The Examiner errs in concluding that Toda reads on storing the modified call count in the memory of the cellular telephone unit. The abstract of Toda describes

"the controller transmits and receives signals between the telephone set and the exchange. The counter is connected to the telephone set for

recording the calls performed. The adder accumulates the calls counted during the discounted tariff time period based on the output of clock. The output of the adder is viewed on the display."

Applicants respectfully submit that in considering the actual scope and contents of Toda, Toda discloses a counter and adder, but Toda does not disclose storing any data in the memory of a cellular telephone unit. In addition, Applicants respectfully submit that in considering the actual scope and contents of Toda, at most Toda discloses a counter that counts the number of calls made during a discount tariff period, and not a duration of any particular call.

In considering the differences between Lahtinen and Toda and claim 32, it is clear that the references, separately or in combination, do not teach or disclose the claimed time increment based call count of the total duration of a call, and in particular, do not teach a timer for counting time increments for the duration of a call. In addition, in considering the differences between Lahtinen and Toda and claim 32, it is clear that the references, separately or in combination, do not teach or disclose modifying a time increment based call count of the total duration of a call based on calling plan parameters, and in particular, do not teach or disclose calling plan parameters for the cellular telephone unit. Further in considering the differences between Lahtinen and Toda and claim 32, it is clear that the references, separately or in combination, do not teach or disclose storing the modified call count in a memory of the cellular telephone unit.

Therefore, in view of the scope and contents of Lahtinen and Toda and the differences between Lahtinen and Toda and claim 32, it is clear that the differences between Lahtinen and Toda and claim 1 are not such that claim 32 as a whole would have been obvious to one of ordinary skill in the art at the time of the invention. In particular, regardless of the Examiner's stated rationale for obviousness, in view of Applicant's remarks and the amendments to claim 32, it is clear that the gap between the prior art and claim 32 is so wide as to render the claims nonobvious to one of ordinary skill in the art. Clearly Lahtinen at most describes limiting the number of calls through a mobile service centre over a time interval and Toda at most describes

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counting and displaying the number of calls made during a discounted tariff time period. It would not be obvious to one of ordinary skill in the art to first modify the counters in Lahtinen to teach determining a call count of a total duration of the call based on time increments counted by the timer, to second modify Lahtinen to teach calling plan parameters for a cellular telephone units, to third modify Lahtinen to teach modifying the call count based on the calling plan parameters, to fourth modify Toda to teach storing a call count in a memory of a cellular telephone device, and to fifth modify Lahtinen by Toda to teach storing the modified call count in the memory of the cellular telephone device.

Applicants respectfully submit that the Examiner's previous rationale for the Examiner's conclusion of obviousness appears to be based on the rationale of "some teaching, suggestion, or motivation in the prior art reference teachings to arrive at the claimed invention" from among the exemplary rationales required to support any rejection under 35 USC §103(a). In particular, the Examiner stated that "it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Lahtinen with that of Toda for the advantage of a subscriber to optimize utilization of discount tariff during a specified time period." [Office Action, p. 16] As to the element of storing the modified call count in the memory of the cellular telephone device, Applicants respectfully submit that the references teach against any motivation to modify Lahtinen by Toda because the proposed modification would change the principle of operation of Lahtinen. Applicants note "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). See also MPEP 2143.01(vi). Lahtinen describes that is desirable to prevent mobile network system overload while storing or updating location information relating to mobile stations in a VLR. *Lahtinen*, col. 2, lines 11-14. Lahtinen addresses a problem at a base station level that is not solved by storing data at the cellular phone level. *Lahtinen*, col. 3, lines 10-46. In fact, storing such data at the cellular phone level

would be harmful, according to Lahtinen, since the data could be lost if the phone is deactivated or leaves the service area. Therefore, combining the alleged teachings of Toda with Lahtinen would destroy the principle of operation of Lahtinen, in contravention of obviousness under §103(a).

Additionally, as to the Examiner's statement in the Office Action that "what is modified in Lahtinen's system is the MS (mobile station), not the network. Stated differently, it would be permissible for one of ordinary skill in the art to modify Lahtinen's MS (mobile station) with the features provided in Toda's handset. Since a handset and a MS are within same field of endeavor, they are combinable without destroying one another, as asserted by appellant" [Office Action, p. 16], Applicants respectfully submitted that regardless of whether an MS of Lahtinen could be modified by Toda, the Examiner relies on the algorithm run by the base stations, not by the MS, in rejecting claim 32, and that the Examiner's proposed modification is one of modifying the base station taught in Lahtinen by the cellular telephone taught in Toda. Thus, the Examiner's proposed modification of Lahtinen by Toda would change the principle of operation of Lahtinen. Moreover, Applicants note that claim 32 is amended to clarify that the method of claim 32 is performed by a controller of a cellular telephone unit.

Because claim 1 as a whole would not have been obvious to one of ordinary skill in the art at the time of the invention, Applicants respectfully request withdrawal of the rejection under 35 USC 103(a) and allowance of the claims. *KSR*, 82 USPQ2d at 1396; *Dann v. Johnston*, 425 U.S. 219, 230 (1976).

Claims 7 and 8 currently read:

Claim 7 (Currently Amended): The method of claim 1 wherein modifying the call count based on calling plan parameters comprises reducing the call count proportional to a pre-determined discount specified in the calling plan parameters for discounting a nighttime call within cutoff times for nighttime hours.

Claim 8 (Currently Amended): The method of claim 1 wherein modifying the call count based on calling plan parameters comprises reducing the call count proportional to a pre-determined discount specified in the calling plan parameters for discounting a weekend call within cutoff times for weekend days.

Applicants note that claims 7, 8, 22, and 23 are amended to more closely conform to the language in paragraph 0023 of the specification and to address the objection and no new matter is added through the amendment. Although Applicants amend the claim in the present application, Applicants do not concede that the Examiner has established a prima facie case of obviousness as to the claims as originally presented. In addition, Applicants respectfully submit that for the same reasons that claim 32 is not obvious under Lahtinen and Toda, claims 7, 8, 22, and 23 are not obvious under Lahtinen and Toda.

In addition, considering the scope and contents of Lahtinen and Toda, Applicants respectfully submit that it is clear that since Lahtinen at most describes a maximum number of calls and a time interval, for a mobile service center, Lahtinen does not teach calling plan parameters specified for discounting a nighttime call within cutoff times for nighttime hours or discounting a weekend call within cutoff times for weekend days. Moreover, in considering the scope and contents of Lahtinen and Toda, Toda describes showing the number of calls counted during a discounted tariff time period, however Toda does not teach reducing any time interval based call count.

In considering the differences between Lahtinen and Toda, Applicants respectfully submit it is clear that neither Lahtinen nor Toda, separately or in combination, describes the claimed element of reducing a time increment based call count proportional to a pre-determined discount specified in the calling plan parameters. Moreover, neither Lahtinen nor Toda describes a calling plan parameter of cutoff times for nighttime hours or cutoff times for weekend days.

Therefore, in view of the gapping differences between the scope and contents of Lahtinen and Toda and the differences between Lahtinen and Toda and claims 7, 8, 22, and 23 each as a whole, Applicants submit that claims 7, 8, 22, and 23 would not have been obvious to one of ordinary skill in the art.

In addition, Applicants respectfully submit that the Examiner's previous rationale for the Examiner's conclusion of obviousness appears to be based on the conclusion of

obviousness as to claim 32, and appears to be based on the rationale of "some teaching, suggestion, or motivation in the prior art reference teachings to arrive at the claimed invention" from among the exemplary rationales required to support any rejection under 35 USC §103(a). In particular, the Examiner stated that "it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Lahtinen with that of Toda for the advantage of a subscriber to optimize utilization of discount tariff during a specified time period." [Office Action, p. 16] As to claims 7, 8, 22, and 23, Applicants respectfully submit that the Examiner has failed to state a motivation for one of ordinary skill in the art to modify Lahtinen's mobile service algorithm which prevents mobile network system overload to teach reducing a time increment based call count by a mobile telephone unit by a predetermined discount specified in calling plan parameters.

Claims 4 and 19

The Office Action rejects claims 4 and 19 under 35 USC 103(a) as being unpatentable over Lahtinen in view of Abe et al. (Abe) (US Patent 5,966,509). [Office Action, p. 9]

Claim 4 currently reads:

Claim 4 (Currently Amended): The method of claim 1 wherein modifying the call count comprises rounding the call count up to a nearest whole minute based on a setting in the calling plan parameters to round to the next whole minute.

Applicants respectfully submit that Lahtinen does not teach the call plan parameters of claims 1 and 16. Lahtinen clearly does not teach a setting in calling plan parameters to round to the next whole minute. The Examiner stated that "it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teachings of Lahtinen with that of Abe for the advantage of providing a better call count management." [Office Action, p. 9] Applicants respectfully submit that the previous rationale stated by the Examiner was not sufficient because Lahtinen only counts each call over a time interval and there is no indication why rounding of a number of calls would provide a better call count management in Lahtinen. Applicants
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have amended claims 4 and 19 as discussed above related to the objections, and in view of the Amendments, Applicants respectfully submit that the previous rationale stated by the Examiner is insufficient to establish prima facie obviousness as to claims 4 and 19.

Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

No extension of time is believed to be necessary. If, however, an extension of time is required, the undersigned hereby authorizes the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,

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